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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/830,647	07/30/2001	Kenichi Arai	2001-0531A	1900

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EXAMINER

YAEN, CHRISTOPHER H

ART UNIT

PAPER NUMBER

1642

DATE MAILED: 11/01/2002

93

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary**Application No.**

09/830,647

Applicant(s)

ARAI ET AL.

Examiner

Christopher H Yaen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,5-7 and 10-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,5-7 and 10-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. The amendments filed 7/15/02 & 7/30/02 (paper no 10 & 11) are acknowledged and entered into the record.
2. Claims 2, 4, 8, and 9 are canceled without prejudice. Claims 18-30 are newly added. Therefore claims 1, 3, 5-7, 10-30 are pending and examined on the merits.

Claim Objections Withdrawn

3. The objection to the disclosure for lacking the phrase "I (We) claim:" or "What is claimed is:" is withdrawn in view of the amendments to the specification

Claim Rejections Withdrawn

4. The rejection of claims 1, 3, and 5 under 35 U.S.C. 101 as claiming unpatentable subject matter is withdrawn in view of the amendments to the claims.
5. The rejection of claims 14-17 under 35 U.S.C. 112 2nd paragraph as being indefinite is withdrawn in view of the amendments to the claims.
6. The rejection of claims 6-7 and 12-15 under 35 U.S.C. 112 1st paragraph as lacking an enabling disclosure is withdrawn in view of the amendments to the claims.
7. The rejection of claims 5-7 under 35 U.S.C 102(e) as being anticipated by Shimkets *et al* is withdrawn in view of the arguments set forth by the applicants.

Claim Rejections Maintained

8. The rejection of claims 1,3,5-7,10-17 and now newly added claims 18-30 are rejected under 35 U.S.C 102 (a) as being anticipated by Kumagai *et al*. Claims 1-17 are rejected for the reasons of record. Newly added claims 18-30 are drawn to an isolated polypeptide comprising SEQ ID No: 1, a polynucleotide and vector comprising SEQ ID

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No: 3 or 4, an isolated antibody, and a method of promoting and suppressing cellular proliferation. Applicant argues that the instant rejection may be overcome upon the filing of a verified translation of the certified priority document. Applicant also noted that 30 October 1998 is the priority date of the instant application.

It is acknowledged that the priority date of the instant application will be granted upon the submission of a translated copy of the foreign priority document, thereby obviating the instant rejection. However, a translated copy of the foreign priority document has not been filed in the instant application. Therefore, the rejection of claims 1-17 and 18-30 are maintained.

New Claim Rejections

Claim Rejections - 35 USC § 112, 2nd paragraph

9. Claims 1, 3, 18, and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims recite the term "comprising", which renders the claim to open interpretation. The metes and bounds of the term cannot be fully determined because the protein of the instant invention may read on a larger portion of a protein not described or disclosed by the specification.

10. It is also noted that the applicant amended the claims to recite an isolated protein. It is appreciated by the examiner that such an amendment has been made to the claims, however, the removal of the term "H37" which adds further clarity and specificity to the claims, renders the claim indefinite. Examiner requests that the term be reintroduced into the claims to help clarify the claims.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher H Yaen whose telephone number is 703-305-3586. The examiner can normally be reached on Monday-Friday 9-5.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa can be reached on 703-308-3995. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-305-3014 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.



Christopher Yaen
Art Unit 1642
October 31, 2002



ALI R. SALIMI
PRIMARY EXAMINER